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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/941,605    09/30/97    WOOD

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EXAMINER

NOLAN, S

ART UNIT

PAPER NUMBER

1772

24

DATE MAILED:

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IM22/0207  
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

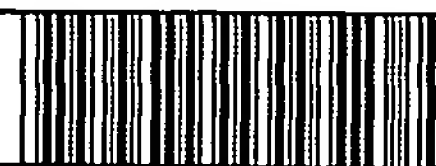
# Office Action Summary

Application No.  
08/941,605

Applicant(s)  
Wood

Examiner  
Sandra Nolan

Group Art Unit  
1772



☒ Responsive to communication(s) filed on Jan. 25, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 9, 13, and 14 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 9, 13, and 14 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Withdrawal of Finality***

1. Pursuant to the agreement reached with Ms. Rena Dye during the personal interview on January 17, 2002, the finality of the Office Action mailed on August 21, 2000 (Paper No. 20) is hereby withdrawn.

### ***Entry of Amendment***

2. The amendment submitted with the response dated January 25, 2001 (Paper No. 23) has been entered. Claims 9, 13 and 14 are pending.

### ***Summary of Claims***

3. Claims 9, 13 and 14 can be summarized as follows:

Claim 9 covers a liner of resin absorbent material for lining a passageway that is connected to a main passageway, which comprises:

a lining tube of resin absorbable flexible material formed with a lumen conforming to the dimension of the lateral and having a collar of that material adapted to conform to the inner surface of the main around the lateral aperture for forming a seal between the main and the lateral.

Claim 13 depends on claim 9 and requires that the material used in the tube and the collar be impregnated with a curable resin. Claim 14 depends on claim 13 and states that the resin in the tube and in the collar are cured at the same time.

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***Rejection Withdrawn***

4. The 35 USC 112 rejections of claim 9 for new matter, as set out in paragraph 4 of Paper No. 20, is withdrawn in view of the amendment to the claims in Paper No. 23.

***Rejection Maintained***

5. The 35 USC 103 rejection of claim 9 (now claims 9, 13 and 14) as unpatentable over Long et al (US 5,108,533), as set out in paragraph 6 of Paper No. 20, is maintained for the reasons recited there.

***New Rejection***

**Claim Rejections - 35 USC § 112**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "curable" is misspelled in lines 2 and 3 of the claim. Please correct.

***Response to Arguments***

8. Applicant's arguments filed in Paper No. 23 have been fully considered but they are not persuasive.

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The responses given at page 4 of Paper No. 20 are still applicable--with the exception of the Examiner's comments re: the new matter rejection. The new matter rejection was obviated by the amendments in Paper No. 23. (See above.)

The process limitation of claim 14 is given no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. In re Brown, 459 F. 2d 531, 173 U.S.P.Q. 685 (C.C.P.A. 1972); In re Fessman, 489 F. 2d 742, 180 U.S.P.Q. 324 (C.C.P.A. 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. In re Fessman, 489 F. 2d 742, 180 U.S.P.Q. 324 (C.C.P.A. 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and MPEP § 2113. In this case, the curing of the resin in the tube and in the collar at the same time does not serve to distinguish the liner from one in which the tube and the collar are cured at different times.

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Nonetheless, note that Long et al use hot water, i.e., feature 182 in Figure 11, to cure their liner (see col. 15, lines 59-63). The collar (Long's "retainer"), 46 in Figure 10, would also be cured when the hot water enters the conduit 48 (see both Figures 10 and 11).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra M. Nolan, whose telephone number is (703) 308-9545. The examiner can normally be reached on Monday through Thursday from 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (703) 308-4251. The fax phone number for the art unit is (703) 305-5408. The telephone number for the receptionist is (703) 308-0661.

*SMN*

SMN/smn

February 5, 2001

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*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772* *2/6/01*